

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Michael Wayne Graham and Robert Norman Rice

Serial No. : 10/646,070 Examiner : Whiteman, Brian A.

Filed : August 22, 2003 Art Unit : 1635

For : CONTROL OF GENE EXPRESSION

30 Rockefeller Plaza
20TH Floor
New York, New York 10112

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TERMINAL DISCLAIMER

Commonwealth Scientific And Industrial Research Organisation, having a place of business at Limestone Avenue, Campbell ACT, Australia, ("CSIRO") is the assignee of the entire right, title and interest in the above-identified application ("the '070 Application") by virtue of the following assignment chain:

- i) Michael Wayne Graham and Robert Norman Rice each on October 19, 2000 signed an Assignment assigning their entire right, title and interest in the invention disclosed in U.S. Serial No. 09/646,807 ("the '807 Application"), and consequently in the '070 Application, which is a continuation of the '807 Application, to Benitec Australia Ltd. and to State Of Queensland Through Its Department Of Primary Industries (Assignment recorded in the U.S. Patent and Trademark Office April 6, 2009 at reel 022521, frames 0407 to 0408);

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ii) State of Queensland Through Its Department Of Primary Industries executed on December 8, 2003 an Assignment of its entire right, title and interest in and to the inventions set forth or claimed in the '070 Application to Benitec Australia Ltd. (Assignment recorded in the U.S. Patent and Trademark Office January 15, 2004 at reel 014264, frames 0687 to 0689); and

iii) Benitec Australia Ltd. executed on August 21, 2006 a Deed of Assignment assigning all of its right, title and interest in and to the '070 Application to CSIRO (Deed of Assignment recorded in the U.S. Patent and Trademark Office November 2, 2006 at reel 018472, frames 0587 to 0595).

Accordingly, the '070 Application is assigned of record solely to CSIRO.

CSIRO is also the assignee of the entire right, title and interest in U.S. Patent No. 6,573,099 ("the '099 Patent"), issued June 3, 2003, by virtue of the following assignment chain:

i) Michael Wayne Graham signed an Assignment on July 17, 1998 assigning his full and exclusive right, title and interest to the invention, for the application from which the '099 Patent issued, the '099 Patent, and any continuation or divisional applications thereof to AG-Gene Australia Ltd. and to State Of Queensland Through Its Department Of Primary Industries (Assignment recorded in the U.S. Patent and Trademark Office August 20, 1998 at reel 009403, frames 0133 to 0134);

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- ii) AG-Gene Australia Ltd. changed its name to Benitec Australia Ltd. on May 2, 2000 (Name Change recorded in the U.S. Patent and Trademark Office October 23, 2000 at reel 011197, frames 0523 to 0524);
- iii) Robert Norman Rice on June 17, 2003 and Michael Wayne Graham on June 30, 2003 each signed an Assignment (Joint) assigning their entire right, title and interest in and to the inventions set forth in the '099 Patent, the '099 Patent, and in and to any and all divisional, continuation and continuation-in-part applications thereof to Benitec Australia Ltd. and State Of Queensland Through Its Department Of Primary Industries (Assignment recorded in the U.S. Patent and Trademark Office July 10, 2003 at reel 013782, frames 0915 to 0916);
- iv) State Of Queensland Through Its Department Of Primary Industries executed on December 8, 2003 a Deed of Assignment assigning all of its rights and interests in the '099 Patent and any divisional, continuation or continuation-in-part applications thereof to Commonwealth Scientific and Industrial Research Organisation (Complete assignment recorded in the U.S. Patent and Trademark Office April 6, 2009 at reel 022482, frames 0882 to 0888);
- v) Benitec Australia Ltd., on March 20, 2009, signed a Deed of Assignment of Patent assigning its entire right, title and interest in and to the '099 Patent to Commonwealth Scientific And Industrial Research Organisation (Assignment recorded in the U.S. Patent and Trademark Office March 20, 2009 at reel 022427, frames 0228 to 0230).

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Accordingly, the '099 Patent is assigned of record solely to CSIRO.

CSIRO hereby disclaims, except as provided below, the terminal portion of the statutory term of any patent granted on the above-identified application and which would extend beyond the expiration date of the full statutory term as defined in 35 U.S.C. §154 to §156 of U.S. Patent No. 6,573,099 and hereby agrees that any patent issued from the subject application shall be enforceable only for and during such period that such patent and U.S. Patent No. 6,573,099 are commonly owned, this agreement to run with any patent granted on the subject application and to be binding upon the grantee, its successors and assigns.

In making the above disclaimer, CSIRO does not disclaim the terminal portion of the term of any patent granted on the subject application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §154 to §156 and §173 of U.S. Patent No. 6,573,099 in the event that such patent expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term.

I have reviewed the assignments referred to herein and certify that, to the best of my knowledge and belief, CSIRO is the assignee of all right, title and interest in and to the subject application and U.S. Patent No. 6,573,099. I further certify that I am authorized to sign on behalf of CSIRO.

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I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that any such willful false statement and the like so made is punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that any such willful false statement may jeopardize the validity of the application or any patent issuing thereon.

Date: 15/12/09

Commonwealth Scientific and
Industrial Research Organisation

By:


Robert Charles de Feyter, Ph.D.
Intellectual Property Manager